



Agilent Ref: 10010016-1
United States Application Serial No. 09/772,723

REMARKS

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Claims 1-44 are pending and claims 15-44 are withdrawn from consideration.

Claims 1-14 were examined and rejected.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Rejections under 35 U.S.C. § 103

Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being obvious over Hankapiller in view of Zeleny, Brown and Bass and claims 1-14 are rejected under 35 U.S.C. § 103(a) as being obvious over Hankapiller in view of Zeleny, Brown, Bass, Shakib and Balaban. *Bass* is a reference used to establish both rejections.

Since Bass was granted *after* the filing date of the instant application, this rejection is a rejection under 35 U.S.C. 103 via 35 U.S.C. 102(e).

Referring to 35 USC § 103(c), MPEP § 706.02(l)(1) states "Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues."

As noted above, the changes made to 35 USC § 103(c) apply to all utility patent applications filed on or after November 29, 1999. Since the instant application was filed on January 29, 2001, which is after November 29, 1999, the above law applies to the instant application.

As such, according to 35 USC § 103(c), if the Bass patent and the instant application were owned by the same person or subject to an obligation of assignment to the same person, at the time the instant invention was made, the Bass patent is not available as prior art against the invention now claimed.

The invention claimed in the instant patent application was owned by Agilent Technologies, Inc. ("Agilent") or subject to an obligation of assignment to Agilent at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Reel/Frame 013156/0848). This assignment was recorded on October 7, 2002.

The Bass patent was owned by Agilent or subject to an obligation of assignment to Agilent at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Reel/Frame 010749/0370). This assignment was recorded on April 10, 2000.

Thus, the subject matter of the cited Bass patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Agilent.

Accordingly to U.S.C. §103(c), therefore, the Bass patent is disqualified as prior art against the claimed invention. Although Bass is one of many references cited in order to establish this rejection, it is *required* to establish the rejection. As such, since Bass is disqualified as prior art against the claimed invention, the rejection cannot be established.

Accordingly, in view of the disqualification of Bass as a prior art reference, these rejections of claims 1-3 and 1-14 under 35 U.S.C. § 103(a) may be withdrawn.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,
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Date: 10.17.03

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